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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,219	04/13/2004	Robert C. Richardson	3287	9067
26645 7590 03/23/2009 THE LUBRIZOL CORPORATION ATTN: DOCKET CLERK, PATENT DEPT. 29400 LAKELAND BLVD. WICKLIFFE, OH 44092				
EXAMINER ALEXANDER, LYLE				
ART UNIT		PAPER NUMBER		
1797				
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03/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,219

Applicant(s)

RICHARDSON ET AL.

Examiner

Lyle A. Alexander

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 10 "the organic solvent bases functional fluid" does not have proper antecedent basis because the language "organic solvent based" has been deleted from the previous portion of the claim. Clarification could be achieved by deleting "organic solvent based" in claim 1 line 10.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 21 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pickup (USP 3,580,704) or Mlinar et al. (USP 4,654,979).

Pickup et al. (USP 3,580,704) teach a colorimetric test for determining the pH of motor oil. Column 3 lines 28 through column 4 line 8 teaches impregnating Kraft paper with bromophenol blue, Alizarin Red, bromocresol green or bromocresol purple which has been read on the claimed "test medium" and "indicator."

Mlinar et al. teach article for testing the pH of organic liquids such as a motor oil (see column 2 lines 48+). The article comprises a support material having at least one

test area that contains an indicator capable of changing color. Column 3 lines 45-50 teach the support material could be an open celled foam material. Examples 1-3 in columns 5-6 teach the indicator is m-cresol purple which is indistinguishable from the claimed indicator.

Claims 1-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Becket (USP 5,710,372).

Becket teaches in the abstract a method for measuring constituents in a lubricating fluid by a colorimetric reaction with a reagent and subsequent comparison to a color calibration scale. Column 8 lines 21+ teach the matrix or test medium can be polymeric fibers which are indistinguishable from the claimed test medium. Column 14 lines 4-31 teach the machining fluid tested contain lubricants and have been read on the claimed "lubricating oils."

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Becket in view of either Pickup et al. or Milner et al.

See Becket, Pickup et al. and Milner et al. supra.

Becket is silent to the claimed indicator.

Pickup et al. and Mliner et al. teach similar colorimetric device that quantify characteristics of an oil. Pickup et al. teach bromophenol blue and Mliner et al. teach m-cresol purple.

MPEP 2144(II)(B) describes a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). A result effective variable is one that has well known and expected results. The selection of a particular indicator, to perform the indicators well known and expected function such as colorimetric determination of an oil's properties, is a result effective variable. It would have been within the skill of the art to modify Becket in view of either Pickup et al. or Mliner et al. and use either bromophenol blue or m-cresol purple as an indicator to achieve their well known and expected functions of colorimetric detection as optimization of a result effective variable.

Response to Arguments

Applicant's arguments filed 1/21/09 have been fully considered but they are not persuasive.

Applicant's argue Becket teaches a water based lubricant that cannot be read on the claimed function fluid that is "... selected from the group consisting of lubricating oils, ...". The instant claim language requires a lubricating oil with an organic solvent base. Becket teaches an organic based lubricating oil as described above. The Office

maintains the instant claim language is sufficiently broad to have been properly read on the taught "lubricating oil".

Applicant's Becket teaches an aqueous based fluid that may contain organic bases lubricants, but that Becket fails to teach or suggest the claimed organic solvent based fluid. The instant claims are not directed to a certain percentage of organic based solvent oil in the fluid. The Office maintains the instant claim language is sufficient broad to have been properly read on any liquid that contains an organic based lubricant, such as that taught by Becket.

Claim 21 has been amended so it does not include the specific indicators taught by Becket. The Office has applied Becket under 35 USC 103.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander
Primary Examiner
Art Unit 1797

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